



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,952	04/06/2000	Arthur R. Francis	RSW9-2000-0008-US1	7895

7590 06/07/2006
Jeanine S Ray-Yarletts
IBM Corporation
T81/062
P O Box 12195
Research Triangle Park, NC 27709

EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
----------	--------------

2178

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/543,952	Applicant(s) FRANCIS ET AL.	
	Examiner Gregory J. Vaughn	Art Unit 2178	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/17/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application Background

1. This action is responsive to the Appeal Brief, filed on 3/15/2006.
2. Claims 1-31 are pending in the application, claims 1, 8, 15 and 22 are independent claims.
3. Applicant's arguments (see page 14, last paragraph to page 16 first paragraph of the Appeal Brief filed 3/15/2006) with respect to the rejections of claims 1-31 made under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection made under 35 USC 103 as being unpatentable over Hawkins et al., US Patent 6,343,318 in view of Ginter et al., US Patent 5,892,900 has been withdrawn, and hence, the finality of the previous office action (dated 12/28/2005) is withdrawn. However, upon further consideration, new grounds of rejection is made with Hawkins in view of Java Servlet Programming, by Jason Hunter, published 11/1/1998, and in further view of Ginter, as described below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

“A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

5. Claims 1, 6, 7, 8, 13, 14, 15, 20-22, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. US Patent 6,343,318, filed 5/29/1998, patented 1/29/2002 (hereinafter Hawkins) in view of Java Servlet Programming by Jason Hunter, published 11/1/1998 (hereinafter Hunter), and in further view of Ginter et al., US Patent 5,892,900, filed 8/30/1996, patented 4/6/1999 (hereinafter Ginter).

6. **Regarding independent claim 1**, Hawkins discloses transforming a file into a pervasive computing device specific file. Hawkins recites: *“The proxy server 180 responds to requests by wireless clients 405 to fetch either web content or messaging information. The proxy server 180 carries most of the burden of bringing the information from the Internet 190, converting it to wireless client 405 compatible CTP and CML formats, and transferring it to the wireless client 405 over the wireless network”* (column 261, lines 17-23).

Hawkins discloses in Figure 1 receiving a request for the original file at a server, the request being sent from a PvC device, the file being stored at the server. As shown in Figure 1, the PvC device is shown at reference sign 100 (described as "*Wireless Communications Device*"), the request is shown at reference signs 122, 124 and 126 (described as "*Wireless CTP Query*", "*CTP Query*" and "*HTTP Query*" respectively), and the server is shown at reference sign 140 (described as "*Web Server*"). The server is shown storing a document at reference sign 144 (described as "*HTML Page*").

Hawkins discloses performing the conversion process steps at the server. Hawkins recites: "*server 180 carries most of the burden of bringing the information from the Internet 190, converting it to wireless client 405 compatible CTP and CML formats, and transferring it to the wireless client 405 over the wireless network*" (column 261, lines 18-23).

Claim 1 is directed toward the file being a Java Server Page (JSP) file. JSP files differ from plain markup language files in that JSP markup includes executable code for program execution, rather than just tags for formatting control. Hawkins discloses that the file contains executable program code. Hawkins recites: "*Alternatively, some programs are customized for accessing specific information from particular web sites. Examples of these programs are Java applets that reside on the client or are served to the client by a server*" (column 3, Lines 14-17).

However Hawkins fails to explicitly recite JSP. Hunter teaches that Java applets that are received from a server (called servlets) are the same as Java

Server Pages. Hunter recites: *"Just as this book was going to press, Sun announced a new way to use servlets, called Java Server pages (commonly, but not officially referred to as JSP). JSP's functionality and syntax bear a remarkable resemblance to Active Server Pages (ASP)"* (first paragraph of section 2.6). Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to use JSP style program code, as taught by Hunter, in the program code enabled files of Hawkins, because Hunter teaches that the functionality and syntax of JSP's resemble other server page languages.

Hawkins discloses modifying the file for a particular user by parsing elements out. Hawkins further recites: *"CGI (Common Gateway Interface) scripts can be supported. CGI scripts are used by the web server 140 to respond to form submissions by browsers and for customizing web content for a particular user. When the browser 104 requests a web document that corresponds to a CGI script, the browser 104 can append text parameters to the end of the base document URL. The proxy server 180 will parse the parameters out"* (column 13, lines 44-51).

Hawkins and Hunter disclose transforming a Java proxy server file application into a pervasive computing device compatible file, where the server will parse specific elements out during the conversion process. Hawkins and Hunter also disclose storing the transformed file. Hawkins and Hunter fail to disclose the masking and unmasking of specific tags in the conversion process. Ginter teaches the use of masking tags. Ginter recites:

Art Unit: 2178

“UDEs 1200 are preferably encrypted using a site specific key once they are loaded into a site. This site-specific key masks a validation tag” (column 150, lines 35-37).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the masking of tags as taught by Ginter with the transformation of files for pervasive computing devices as taught by Hawkins and Hunter in order to *“maintain the integrity, availability, and/or confidentiality of such information and processes related to such use”* (Ginter, column 1, lines 13-15).

7. **Regarding independent claims 8, 15 and 22**, the claims are directed toward an apparatus, a computer program and a system (respectively) for the method of claim 1, and remain rejected using the same rationale.
8. **In regard to dependent claims 6-7, 13-14, 20-21 and 27-28**, the claims remain rejected for fully incorporating the deficiencies of their base claims.
9. Claims 2, 3, 9, 10, 16, 17, 23 and 24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of Hunter, further in view of Ginter and further in view of Judson US Patent 6,185,586 (filed 4/6/1998, patented 2/6/2001).
10. **In regard to dependent claims 2 and 3**, Hawkins and Hunter disclose transforming a Java proxy server file application into a pervasive computing device compatible file, where the server will parse specific elements out

Art Unit: 2178

during the conversion process. Hawkins and Hunter also disclose storing the transformed file. Hawkins, Hunter and Ginter disclose masking as described above. Hawkins, Hunter and Ginter fail to disclose masking by use of comment tags. Judson teaches the use of comments tags to mask. Judson recites: "*Preferably, the information object is masked by an HTML comment tag, which may include other HTML tags nested therein to format the information in the object*" (column 3, lines 2-3).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the transformation of files for pervasive computing devices by masking tag as taught by Hawkins, Hunter and Ginter with the comment masking of Judson so that "*the information is preferably "hidden" within the web page using a hypertext markup comment tag*" (Judson, column 2, lines 58-59).

11. **Regarding dependent claims 9-10, 16-17 and 23-24**, the claims are directed toward an apparatus, a computer program and a system (respectively) for the method of claims 2-3, and remain rejected using the same rationale.
12. Claims 4-5, 11-12, 18-19 and 25-26 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of Hunter, further in view of Ginter and further in view of Ramaley et al. US Patent 6,585,777, filed 1/19/1999, patented 7/1/2003 (hereinafter Ramaley).

Art Unit: 2178

13. In regard to dependent claim 4 and 5, Hawkins and Hunter disclose transforming a Java proxy server file application into a pervasive computing device compatible file, where the server will parse specific elements out during the conversion process. Hawkins and Hunter also disclose storing the transformed file. Hawkins, Hunter and Ginter disclose masking as described above. Hawkins, Hunter and Ginter fail to disclose storing with a unique file name or file extension. Ramaley discloses *"Assign Unique Identifier Comprising Fixed String and Unique Instance Number"* at reference 620 in Fig. 6. Ramaley teaches the use of unique file naming

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to add the file naming of Ramaley to the transformation of files for pervasive computing devices by masking tag as taught by Hawkins, Hunter and Ginter to provide the benefit of *"placing information in a primary file that provides a cue"* (Ramaley, column 3, lines 7-8).

14. In regard to dependent claims 11-12, 18-19 and 25-26, the claims are directed toward an apparatus, a computer program and a system (respectively) for the method of claims 4-5, and remain rejected using the same rationale.

15. Claims 29-31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of Hunter, further in view of Ginter and

Art Unit: 2178

further in view of Toyouchi et al. US Patent 6,847,988, filed 9/13/1999, patented 1/25/2005 (hereinafter Toyouchi).

16. **Regarding dependent claim 29**, Hawkins, Hunter and Ginter disclose a method for transforming an original JSP file into a PvC device specific file, and locating the original JSP file on the server as described above. Hawkins, Hunter and Ginter fail to disclose determining the type of PvC device based upon the header information of the request. Toyouchi discloses using the header information of a request to determine the type of device, Toyouchi recites: *"In FIG. 53, there is shown a format of a message transmitted/received between the information acquiring computer and the service providing computer. The message contains a header portion 701 and a data portion 702. The header portion 701 contains a destination address 7011, a source (sender) address 7012, a session ID 7013 capable of uniquely discriminating a session start to an end from the client application (browser), namely a combination with an address (for instance, IP address+port) and a time instant, a serial number 7014 within a session, a terminal sort 7015 for indicating a type of a terminal"* (column 38, line 66 to column 39, line 9).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the use of identifying information contained in the header of a request, as taught by Toyouchi, with the JSP to PvC transforming method of Hawkins, Hunter and Ginter in order to provide *"more effective information service utilization by end users"* (Toyouchi, column 2, line 47).

Art Unit: 2178

17. **Regarding dependent claims 30-31**, the claims are directed toward a computer program and a system (respectively) for the method of claims 29, and remain rejected using the same rationale.

Response to Arguments

18. Applicant's arguments (see page 14, last paragraph to page 16 first paragraph of the Appeal Brief filed 3/15/2006) with respect to the rejections of claims 1-31 made under 35 USC 103 have been fully considered and are persuasive.

19. **Regarding claim 1**, the applicant argues that the previous office action (dated 12/28/2005) fails to produce a *prima facie* case for three reasons; First, that the cited art would not meet the features claimed, Second that one of ordinary skill would not be motivated to combine the references, and third that the references are not analogous art.

In response to the first reason, the examiner found the arguments persuasive and has withdrawn the rejection, as described above. However, upon further consideration, new grounds of rejection are presented, as described above.

In response to the second reason (i.e. that there is no suggestion to combine the references), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or

Art Unit: 2178

motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ginter provides motivation to combine the masking of tags as taught by Ginter with the transformation of files for pervasive computing devices as taught by Hawkins and Hunter in order to “*maintain the integrity, availability, and/or confidentiality of such information and processes related to such use*” (Ginter, column 1, lines 13-15).

Also, applicant argues that the reference teaches away, because the person of ordinary skill would be discouraged from following the path set out by the reference, and in particular points out that Hawkins has a step where the file is transferred from the server to the client in a compressed binary data format, and that the binary data format teaches away because the compressed format would negatively affect the JSP tags of the current application. In response the examiner would point out that applicant's claimed invention fails to disclose a file-transferring step, and second that the Hawkins' invention is directed toward conversion of files for use on pervasive computing devices within a low-bandwidth environment (where the low-bandwidth issue is overcome by the compression step). Applicant's claimed invention is directed toward conversion of files for use on a pervasive computing device, where the file includes executable components in the form of JSP elements. One of ordinary skill would be drawn to Hawkins, at the very

Art Unit: 2178

least, to learn how Hawkins achieved the conversion process, and as described above, it would have been obvious to one of ordinary skill to modify Hawkins with Hunter and Ginter to produce the claimed invention.

In response to the third reason, that Ginter is non-analogous art, the examiner respectfully disagrees. Both Hawkins and Ginter are directed toward the management of electronic information that is exchanged over a wide area network. Both Hawkins and Ginter are directed toward modifying the information, as needed, to allow the information to be used by different kinds of computing devices, and even removing content or formatting in response to device capabilities.

The balances of applicant's arguments are directed toward substantially the same arguments as presented above.

Art Unit: 2178

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
May 23, 2006


STEPHEN HONG
SUPERVISORY PATENT EXAMINER